

REMARKS

The last Office Action of March 21, 2011 has been carefully considered. Applicant hereby requests reconsideration of the claims in response to the Examiners rejection of the claims. Claims 27-48 and 50-52 [sic].

As it was pointed out by the Examiner, claim 49 was missing, applicant has renumbered the claims to correct the numbering from claims 50-52 to 49-51 and to bring them in better form for appeal. Other than renumbering these claims, no claims were substantively amended.

Claims 27-38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Morgan in view of U.S. Pat. No. 6,466,830 to Manross ("Manross") and U.S. Patent No.: 7,098,942 to Nihei ("Nihei").

Claims 39-48, 50 and 52 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Morgan in view of US Publication 2002/0154327 to Jones ("Jones").

Claim 51 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Morgan in view of Jones and US 2004/0085449 to Millett ("Millett").

REJECTION OF CLAIMS 27-38 UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER MORGAN IN VIEW OF MANROSS AND NIHEI

Turning now to the rejection of claims 27-38, the Examiner rejects claim 27 reciting the steps, the Examiner sees as being taught by Morgan. With respect to step c) the Examiner cites paragraph [0102] in Morgan as providing "*...a motif or a picture, card or item form standard motifs available from stored motifs...*". As to the second part of step c) the Examiner has not provided any references from Morgan. The reason the Examiner has not provided any is that Morgan does not teach "*one or more motifs supplied by the user and embedding the motif in a layout*".

Applicant in its description in the paragraph bridging pages 6/7, lines 28-29/1-2, it is stated that the use can supply motifs that are stored on a storage medium that can be read by applicant's device.

Nowhere in the Examiner's analysis is that aspect mentioned. Thus the Examiner's rejection cannot stand on Morgan.

The Examiner, while using Morgan as the main reference, now newly cites the Manross and Nihei references.

Morgan lacks major steps which are considered central to applicant's invention. These are: Morgan does not teach providing for user's storage medium with motifs to be read by the device; Morgan does not teach activating a language a communication and language selection; Morgan does not teach leaving activating the billing and payment function at the end of the transaction, but requires payment up front. These are major functions of the device according to the present invention. These steps are essential for the functioning of the device; they are not steps that can be rearranged in any sequence.

Nonetheless, the Examiner provides Manross that is supposed to teach the communication and language selection. Indeed, the Examiner uses Morgan as a template to fill in one of the steps that are missing in Morgan. Manross is not relevant for the person skilled in the art in this context since Manross is directed to a completely different market when providing e-pictures, as compared to the Morgan kiosk. The Morgan kiosk provides product right then and there. Manross does not print anything. So, there is not motivation for the skilled person to look to Manross, when each Morgan and Manross deliver such diverging products. The Examiner states that Manross and Morgan are in the field of endeavor of photo kiosk. Applicant contends that each provide a very different function even though they both may include photos in some manner; but their product is completely different. One provides a product at the kiosk, the other does not.

With respect to Nihei, that reference does not refer to a "foto kiosk" because no photos are being generated or offered in this device. Moreover, with respect to the payment function, a preliminary payment of \$1 is required as a policing step and therefore is a completely different device. In the industry to which the present invention is directed, a major point is to inspect the product before payment is to be made. Again, the person skilled in the art would not have been motivated to look to this device in order to conceive of the present invention.

In summary, the Examiner has not shown the requisite motivation that the person skilled in the art would turn to the Manross and Nihei applications to conceive of the device according to claims 27-38.

Obviousness requires a suggestion of all the elements in a claim and a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in a way the claimed new invention does. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 [82 USPQ2d 1385] (2007). In the case at hand, the Examiner has not identified all the elements of claim 27, nor provided any reason that would have prompted the skilled worker to have arranged them in the manner necessary to reach the claimed invention. *Ex Parte Alexander*, 86 USPQ2d, 1120, 1122, U.S.P.T.O. Board of Patent Appeals and Interferences (2007).

Withdrawal of the rejection of claim 15 under 35 U.S.C. §103(a) and allowance thereof are thus respectfully requested.

REJECTION OF CLAIMS 39-48 AND 50-52 UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER MORGAN IN VIEW OF JONES

The Examiner's rejection of claims 39, alleging the structures recited are met by the Morgan reference. With respect to structure e) the Examiner states that Morgan in paragraph [0108]/[0109] has an internet connection. The recitation requires "*at least one interface communication with external storage media and internet connection*" Again, Morgan does not teach communicative external storage media capacity neither in paragraphs [0108]/[0109] or anywhere else.

The Examiner also considers Morgan a "postcard printing photo kiosk" referring to paragraph [0075] in Morgan. There is no description as actually provide a postcard with two-sided printing. All it says in Morgan that the device can be used to provide postcards and matchbooks. In other words, since the main example given in Morgan is for a deck of cards that can be printed with the face of the person requesting it, two sides of the each card of the deck of cards are images that are stored in the device, with one being generated by the user through a camera. This is very different from providing a postcard that is printed on two sides, where one side.

With respect to Jones, that reference per se does not disclose a camera connected with the device. In Jones, the kiosk refers to a "further processing kiosk" ([0023] and Figure 2). Referring to Figure 1, it describes that the camera is outside the device claimed. While in [0018] it is described that a camera can be connected, it does not specify that personal photos can be taken by the kiosk. As such Jones teaches a printer, not a photo kiosk.

The remainder of the Examiner's rejection enumerates each structure in claims 39-48 and 50-52 with a structure found in Morgan with the exception of the postage unit for which the Jones reference is cited.

With respect to claim 45, the Examiner claims that the device in Morgan teaches an interface which is suitable for various storage media pointing to paragraphs [0097] [0109] in Morgan. Again, there is nothing in those paragraphs that point to interfacing with a user's media for supplying an image of the user. All that paragraph [0097] recites relates to audio information. Re: [0109] Morgan refers to remote location of an image device.

Based on the foregoing discussion, it is clear that the Examiner has not met the level necessary to determine the claims obvious in view of Morgan and Jones wherever Jones applies.

Withdrawal of the rejection of claims 39-48 and 50-52 under 35 U.S.C. §103(a) and allowance thereof are thus respectfully requested.

THE EXAMINER'S REJECTION OF CLAIMS 27-38 AND 39-48, 50-52 IS BASED ON HINDSIGHT

Applicant notes that in the last response applicant submitted new claim 27 in which the only changes related to succession of steps, that is, the steps as recited are now indicated as following. As a result, the Examiner has dropped the references other than Morgan and supplies further references that serve to provide the steps respectively the structures of claim 27 and claim 39 and the features in the claims depending therefrom.

Moreover, it is applicant's contention that the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the

teachings of the prior art so that the claimed invention is rendered obvious. *In re Gorman* 933 F.2d 982.

In the case at hand, Morgan clearly does not teach the desire to supply user's media, as discussed above. There is no teaching or suggestion supporting the combination as proposed by the Examiner. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 733 F.2d at 902.

Although the nature of the problem addressed by the reference may be the same, an artisan will not find motivation to make the combination as suggested by the Examiner because the solution proposed by the reference to this problem teaches away from the subject matter of the present invention.

Applicant respectfully submits that the combination of Morgan/Jones/Nihei/Jones/ Millett is improper because the Office Action relies on information gleaned solely from Applicant's specification. MPEP § 2142 states that "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art" (emphasis added). "Any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper" (MPEP § 2145(X)(A), quoting *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971), (emphasis added).

In the present case, the Office Action relied on simply combining the references to allegedly support the combination of the references. However, the references are not in the same field of endeavor and is only present in Applicant's specification. Accordingly, it is respectfully submitted that the combination is improper and respectfully requested that the rejection be withdrawn.

CONCLUSION

Applicant believes that when reconsidering the claims in the light of the above comments, the Examiner will agree that the invention is in no way properly met or anticipated or even suggested by any of the references however they are considered.

None of the references discloses a method and devices for the individual location-independent designing of images, cards and similar having features as set forth in the claims.

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

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